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August 7, 2008

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Commissioner for Patents
PO Box 1450
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Art Unit 1645

Attn: Mail Stop Amendment

Re: U.S. Utility Patent Application
Application No. 12/098,577; Filed: April 7, 2008
For: **PCA3 Messenger RNA Species in Benign and Malignant Prostate
Tissues**
Inventors: BUSSE *et al.*
Our Ref: 1619.0080002/JAG/CMB

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Information Disclosure Statement Under 37 C.F.R. § 1.97(b);
2. Form PTO/SB/08b (4 sheets) listing **85** cited documents (**US1-US57** and **FP1-FP28**);
3. Form PTO/SB/08b (9 sheets) listing **83** cited documents (**NPL1-NPL83**); and
4. Copies of **28** cited documents (**FP2, FP4, FP5, FP7, FP9, FP10, FP12 to FP14, FP17 to FP19, FP23**) and (**NPL1 to NPL5, NPL7 to NPL9, NPL17, NPL22 to NPL31, NPL33 to NPL45, NPL47 to NPL50, NPL52 to NPL63, NPL65 to NPL76, and NPL78 to NPL82**); and
5. One (1) return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier.

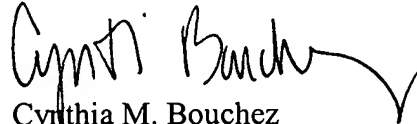
In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents
August 7, 2008
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The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

A handwritten signature in black ink, appearing to read "Cynthia M. Bouchez", with a large, sweeping flourish extending to the right.

Cynthia M. Bouchez
Attorney for Applicants
Registration No. 47,438

UWJ/CMB:trh
Enclosures

857719_1.DOC



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BUSSE *et al.*

Appl. No.: 12/098,577

Filed: April 7, 2008

For: **PCA3 Messenger RNA Species in
Benign and Malignant Prostate
Tissues**

Confirmation No.: 2665

Art Unit: 1645

Examiner: *To Be Assigned*

Atty. Docket: 1619.0080002/JAG/CMB

**Information Disclosure Statement
37 C.F.R. § 1.97(b)**

Mail Stop Amendment

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Listed on the accompanying IDS Forms, PTO/SB/08A and PTO/SB/08B, are documents that may be considered material to the patentability of this application as defined in 37 C.F.R. §1.56, and in compliance with the duty of disclosure requirements of 37 C.F.R. §§ 1.97 and 1.98.

Copies of documents **FP2, FP4, FP5, FP7, FP9, FP10, FP12 to FP14, FP17 to FP19, FP23, NPL1 to NPL5, NPL7 to NPL9, NPL17, NPL22 to NPL31, NPL33 to NPL45, NPL47 to NPL50, NPL52 to NPL63, NPL65 to NPL76, and NPL78 to NPL82** are submitted. However, copies of U.S. patents and patent application publications cited on the attached Form PTO/SB/08A, documents **US1 to US57**, are not submitted in accordance with 37 C.F.R. § 1.98(a)(2). In addition, a copy of document **NPL83** is not provided in accordance with the U.S. Patent and Trademark Office OG notice of October 19, 2004, which states: "the requirement in 37 C.F.R. § 1.98(a)(2)(iii) for a legible copy of the specification, including the claims, and drawings of each cited pending U.S. patent

application (or portion of the application which caused it to be listed) is *sua sponte* waived where the cited pending application is stored in the USPTO's IFW system."

Copies of documents **FP1, FP3, FP6, FP8, FP11, FP15, FP16, FP20 to FP22, FP24 to FP28, NPL6, NPL10 to NPL16, NPL18 to NPL21, NPL32, NPL46, NPL51, NPL64, and NPL77** were cited by or submitted to the Office in an Information Disclosure Statement that complies with 37 C.F.R. § 1.98(a)-(c) in Application No. 09/675,650, filed September 29, 2000, which is relied upon for an earlier filing date under 35 U.S.C. § 120. Thus, copies of these documents are not attached. 37 C.F.R. § 1.98(d).

The Examiner's attention is directed to the following co-pending U.S. Patent Applications, which are directed to related technical subject matter:

Application No. 10/880,425, inventors Schalken, *et al.*, filed June 30, 2004; published on July 28, 2005 as U.S. Publication No. 2005/0164223 A1 and cited herewith as **US55**;

Application No. 10/773,440, inventors Fradet, *et al.*, filed February 9, 2004; published on December 22, 2005 as U.S. Publication No. 2005/0282170 A1 and cited herewith as **US56**;

Application No. 11/260,282, inventors Bussemakers, *et al.*, filed October 28, 2005; published on May 11, 2006 as U.S. Publication No. 2006/0099658 A1 and cited herewith as **US57**; and

Application No. 11/794,048, inventors Hessels, *et al.*, filed December 23, 2005;
NOT YET PUBLISHED and cited herewith as **NPL83**.

In accordance with the Federal Circuit decision in *Dayco Prods., Inc. v. Total Containment, Inc.* 329 F.3d 1358 (Fed. Cir. 2003), Applicants submit herewith Office Actions from:

the related co-pending U.S. Patent Application No. 09/996,953 as Document **NPL81**;

the related co-pending U.S. Patent Application No. 10/773,440 as Document **NPL82**; and

the related issued Patent No. 6,897,024 as Document **US48**.

The identification of these U.S. Patent Applications and Office Actions is not to be construed as a waiver of secrecy as to those applications now or upon issuance of the present application as a patent. The Examiner is respectfully requested to consider the cited applications and the art cited therein during examination.

Where the publication date of a listed document does not provide a month of publication, the year of publication of the listed document is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the month of publication is not in issue. Applicants have listed publication dates on the attached IDS Forms based on information presently available to the undersigned. However, the listed publication dates should not be construed as an admission that the information was actually published on the date indicated.

Applicants reserve the right to establish the patentability of the claimed invention over any of the information provided herewith, and/or to prove that this information may not be prior art, and/or to prove that this information may not be enabling for the teachings purportedly offered.

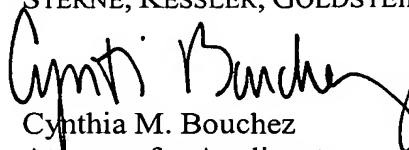
This statement should not be construed as a representation that a search has been made, or that information more material to the examination of the present patent application does not exist. The Examiner is specifically requested not to rely solely on the material submitted herewith.

It is respectfully requested that the Examiner initial and return a copy of the enclosed IDS Forms, and indicate in the official file wrapper of this patent application that the documents have been considered.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.


Cynthia M. Bouchez
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Date:

August 6, 2008

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